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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/715,439

11/16/2000

Shelton Louie

1205-002/JRD

5706

67701

7590

06/11/2009

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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3687

MAIL DATE

DELIVERY MODE

06/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/715,439	Applicant(s) LOUIE ET AL.	
	Examiner VANEL FRENEL	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,44-51,62,63 and 65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-6, 44-51, 62-63, and 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Pre-Appeal Brief filed on 3/4/09. Claims 3, 7-43, 52-61, and 64 have been cancelled. Claims 1-2, 4-6, 62-63 are pending.
2. Applicant's arguments filed on 3/04/09 in the Pre- Appeal Brief have been persuasive, therefore the previous Office Action has been vacated and a New Office Action is hereby presented with a New Grounds of Rejection.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 1-2, 4-6, 44-51, 62-63, and 65 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-2, 4-6, 44-51, 62-63, and 65 are rejected under 35 U.S.C. 101 because invention is directed to non-statutory subject matter. The claims recite said method including the following steps of receiving, operably securing, associating, moving, automatically, and moving. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008);

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Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 1-2, 4-6, 44-51, 62-63, and 65 are non-statutory since they may be performed within the human mind.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-6, 62-63 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey (6,611,806) in view of Lasher et al. (5,771,657) and further in view of McDonald et al. (5,593,267).

As per claims 1 and 62, Harvey discloses a method for tracking prescription orders through a pharmacy having a plurality of physically spaced apart locations for filling the prescription order, the plurality of spaced apart locations positioned along a workflow stream leading to a storage area with an array of compartments for storing filled prescription orders therein, said method including the following steps: receiving a prescription order at a first location upstream of the storage area (See Harvey, Co1.12, lines 25-36); operably securing remote machine-readable tag to the prescription order upstream of said storage area, said tag having a unique identifier that is readable by a tag reader in proximity to the tag regardless of its orientation relative to the tag reader (See Harvey, Co1.4, lines 16-56); associating the unique identifier of the tag with customer information stored in a computer system in association with the prescription order (See Harvey, Co1.4, lines 4-31).

Harvey does not explicitly disclose that the method having manually moving the prescription order to one of the compartments in the array of compartments as a filled prescription order compartment having a corresponding compartment tag reader that is in communication with the computer system and is operable to read the unique identifier of the tag on the filled prescription order regardless of the orientation of the tag; and automatically recording at the computer system the compartment where the filled prescription order at said second location and updating the computer system to indicate that the prescription order is not at the second location.

However, these features are known in the art, as evidenced by Lasher. In particular, Lasher suggests that the method having manually moving the prescription

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order to one of the compartments in the array of compartments as a filled prescription order compartment having a corresponding compartment tag reader that is in communication with the computer system and is operable to read the unique identifier of the tag on the filled prescription order regardless of the orientation of the tag (See Lasher, Co1.13, lines 19-47; Co1.15, lines 1-15) and automatically recording at the computer system the compartment where the filled prescription order at said second location and updating the computer system to indicate that the prescription order is not at the second location (See Lasher, Co1.3, lines 60-67 to Co1.4, line 31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Lasher within the system of Harvey with the motivation of providing a computer system called a Pharmacy Automation Computer (PAC) controls print, apply, and load stations (PAL stations), which print prescription labels, apply the labels to prescription bottles and load the labeled prescription bottles onto carriers (See Lasher, Co1.1, lines 56-67).

Harvey and Lasher disclose all the limitations above. The combination of Harvey and Lasher does not explicitly disclose "moving the prescription orders by hand to a second location within the pharmacy for manually filling upstream of the storage area, the second location having a second location tag reader in communication with the computer system"; automatically detecting the presence of the prescription orders at the second location by reading the unique identifier of the remote tags with said second location tag reader regardless of the orientation of said tags and automatically recording

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at the computer system the location of the prescription orders at said second location for the manual filling".

However, these features are known in the art, as evidenced by McDonald. In particular, McDonald discloses that the method having "moving the prescription orders by hand to a second location within the pharmacy for manually filling upstream of the storage area, the second location having a second location tag reader in communication with the computer system (See McDonald, Figs.7-10; Co1.5, lines 63-67 to Co1.6, line 50; Co1.9, lines 35-67 to Co1.10, line 40)"; automatically detecting the presence of the prescription orders at the second location by reading the unique identifier of the remote tags with said second location tag reader regardless of the orientation of said tags and automatically recording at the computer system the location of the prescription orders at said second location for the manual filling" (See McDonald, Figs.7-10; Co1.5, lines 63-67 to Co1.6, line 50; Co1.9, lines 35-67 to Co1.10, line 40)".

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of McDonald within the collection of Lasher and Harvey with the motivation of providing a second rack or a designated portion of the main storage rack for receipt of new or return items to be restocked (See McDonald, Co1.3, lines 16-20).

As per claim 2, Lasher discloses the method for tracking prescription orders through a pharmacy of claim 1, further including the steps of: displaying the location of

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the prescription order on a computer system display, thereby facilitating the easy location of said prescription order (See Lasher, Co1.5, lines 1-20).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

As per claim 4, Harvey discloses the method for tracking prescription orders through a pharmacy further including the steps of: automatically collecting timing information about the amount of time the prescription order remains at the second location (See Harvey, Co1.3, lines 45-67); storing said timing information into the computer system (See Harvey, Co1.7, lines 52-67); and, compiling workflow information based on the timing information (See Harvey, Co1.10, lines 6-22).

As per claim 5, Harvey discloses the method for tracking prescription orders through a pharmacy further including the step of: associating the workflow information with a particular worker to evaluate worker efficiency (See Harvey, Co1.12, lines 44-57).

As per claim 6, Harvey discloses the method for tracking prescription order through a pharmacy wherein said pharmacy is a retail pharmacy (See Harvey, Co1.4, lines 16-28).

As per claim 63, McDonald discloses a method tracking physical location of prescription orders through a pharmacy, further including the steps of: displaying on a

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computer system the compartment in which any selected prescription order was stored by hand, thereby facilitating the easy location of said prescription order by a pharmacy worker (See McDonald, Co1.5, lines 65-67 to Co1.6, line 50).

As per claim 65, McDonald discloses the method further including: detecting removal of a filled prescription order and its associated tag from a selected compartment in the storage area with the compartment tag reader corresponding to the selected compartment (See McDonald, Co1.5, lines 65-67 to Co1.6, line 50).

6. Claims 44-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey (6,611,806) in view of Lasher et al (5,771,657) as applied to claims 1-6, 9-10, 13, 15-23 above and further in view of Garber et al (6,448,886).

Claim 44 differs from claim 1 by reciting a method for ensuring that a pharmacy worker distributes the correct prescription order to a customer of the pharmacy, the pharmacy having a storage portion with an array of individually identified storage areas therein, each individually identified storage area having a unique visual identifier.

As per this limitation, it is noted that Harvey discloses said method comprising: receiving a prescription order at a first location spaced apart from the storage area within the pharmacy (See Harvey, Co1.8, lines 6-61); operably securing a machine-readable tag to the prescription order, the machine-readable tag having a unique tag identifier readable when placed in proximity to each a tag reader regardless of orientation of the tag relative to the tag reader (See Harvey, Col.4, lines 16-56);

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associating the machine-readable tag with customer information associated with the prescription order in the computer system (See Lasher, Co1.3, lines 60-67); manually filling the prescription order defining a filled prescription order (See Lasher, Co1.31-59); placing the filled prescription order and the machine-readable tag into one individually identified storage area of the plurality of individually identified storage areas without instructions from the computer system as to which individually identified storage area the filled prescription order and the remote machine-readable tag are to be placed thereby defining a pharmacy worker selected storage area (See Lasher Co1.3, lines 31-67 to Co1.4, line 4); reading the unique tag identifier of the tag within the pharmacy worker selected storage area with a tag reader that is associated with the pharmacy worker selected storage area, but not with any other individually identified storage areas in the array (See Lasher, Co1.4, lines 54-67 to Co1.5, line 37); retrieving the customer information from the computer system to determine the storage area identifier associated with the pharmacy worker selected storage area in which the customer's filled prescription order is located (See Lasher, Co1.5, lines 1-37); and, retrieving the filled prescription order from the identified pharmacy worker selected storage area of the storage portion (See Lasher, Co1.5, lines 1-37) and Garber discloses providing the unique tag identifier and the storage area identifier for the pharmacy worker selected storage area to the computer system (See Garber, Co1.17, lines 1-48); the computer system correlating the customer information, unique tag identifier, and storage area identifier (See Garber, Co1.17, lines 1-48).

Thus, it is readily apparent that these systems utilize a method for ensuring that a pharmacy worker distributes the correct prescription order to a customer of the pharmacy, the pharmacy having a storage portion with an array of individually identified storage areas therein, each individually identified storage area having a unique visual identifier to perform their specified function.

The remainder of claim 44 is rejected for the same reasons given above for claims 1 and 62, and incorporated herein.

As per claim 45, Garber discloses the method wherein said tag is a radio-frequency identification ("RFID") tag and said tag readers are RFID readers (See Garber, Co1.5, lines 24-60).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

As per claim 46, Lasher discloses the method wherein said storage area identifier is not related to information contained within the customer information (See Lasher, Co1.1, lines 11-26).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

As per claim 47, Lasher discloses the method wherein said storage area identifier is numeric (See Lasher, Co1.4, lines 54-67).

The motivation for combining the respective teachings of Harvey and Lasher are as discussed in the rejection of claim 1 above, and incorporated herein.

As per claim 48, Harvey discloses the method further including: detecting the removal of the tag from the pharmacy worker selected storage area by the tag reader associated with the pharmacy worker selected storage area (See Harvey, Co1.8, lines 6- 42).

As per claim 49, Harvey discloses the method further including: monitoring with the computer system the time the tag remains within the pharmacy worker selected storage area (See Harvey, Co1.8, lines 6-42).

As per claim 50, Harvey discloses the method, further including placing a second filled prescription order with a second unique remote tag operably secured thereto within the pharmacy worker selected storage area such that the filled prescription order and the second filled prescription order concurrently occupy the same pharmacy worker selected storage area, and wherein the computer system associates customer identifying information for the second filled prescription, the second prescription order and the storage identifier (See Harvey, Col.8, lines 19-61).

As per claim 51, Harvey discloses the method, wherein the computer system detects the removal of the prescription order from the pharmacy selected storage area

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during the retrieving the prescription order step, and detects the continued presence of the second prescription order within the pharmacy selected storage area during the retrieving the prescription order step (See Harvey, Col.8, lines 19-61).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/

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June 8, 2009